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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,483	09/19/2003	Manuel Becerra	006128/260159	4368
826 7590 04/19/2007 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER COBANOGU, DILEK B	
			ART UNIT	PAPER NUMBER
			3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/664,483

Applicant(s)

BECERRA ET AL.

Examiner

Dilek B. Cobanoglu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17, 19-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/21/2004, 01/09/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the election for restriction and amendment filed 03/20/2007. Claims 1-9, 17, 19-27 and 29-30 have been elected. Examiner considers that Applicant meant to cancel the claims 18 and 28, even though the "Remarks" states claims 8 and 18 have been cancelled. Therefore claims 1-17, 19-27 and 29-30 are still pending.

Specification

2. The amendment filed 09/25/2006 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added recitation of "selling a particular article of personal property" within claims 1, 2, 4-6, 17, 23-26 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find, any support for a "particular article of personal property" determination and display feature within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9, 17, 19-27, 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claims recite "selling a particular article of personal property", which is not described in the Applicant's specification. The Applicant's specification recites "selling a service contract" (specification, page 2, lines 8-20), and "customer purchases a particular item" (specification, page 8, lines 1-6).

Independent claim 1 and 17 recite limitations that are new matter, as discussed above.

Claims 2-9, 19-27, and 29-30 incorporate the deficiencies of independent claims 1 and 17, through dependency, and are also rejected.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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6. Claims 1-9, 17, 19-27 and 29-30 are rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

A. Claims 1, 2, 4-6, 17, 23-26 have been amended now to recite the feature of "selling a particular article of personal property". However, it is unclear as to what a "particular article of personal property" is. Does Applicant seek patent protection for selling an "item" or "personal property" or "contract for a personal property" or "contract for an item" or a "property insurance policy" or an "insurance policy for an item"?

B. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: evaluating or reviewing the service contract and how to provide the insurance coverage.

Applicant amended claim 1 to include "selling, by a first party, a particular article of personal property to said customer"; this step does not cover the step of evaluating or reviewing the service contract and how to provide the insurance coverage.

C. The 35 U.S.C. 112, second paragraph rejection of claims 27 and 29, as being indefinite and unclear, has been withdrawn due to the amendment made to these claims.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. 35 U.S.C. 101 rejection of claims 1-9, 17, 19-27 and 29-30 has been withdrawn due to the amendment made to the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9, 17, 19-25, 27, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (hereinafter Becker) (U.S. Patent Publication No. 2002/0165741 A1) in view of Levison (U.S. Patent Publication No. 2002/0010599 A1).

NOTE: The following rejections assume that the subject matter added in 09/25/2006 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 2-4 above in the next communication sent in response to the present Office Action.

A. Claim 1 has been amended now to recite "a method of providing insurance to a customer, said method comprising the steps of:

- i. Selling, by a first party, a particular article of personal property to said customer(Becker; abstract, paragraph: 0013);
- ii. Selling, by said first party, a service contract to said customer, said service contract providing protection against the mechanical breakdown or other failure of said article of personal property (Becker; abstract, paragraph: 0013, 0015); and
- iii. in response to said customer purchasing said service contract, providing, at no cost to said customer, insurance coverage that protects said customer against loss of said article of personal property, (Becker; abstract, paragraph: 0013, 0015), wherein: said insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party."

Examiner considers that "the article of personal property" is "a particular item" or "an item" as recited in the original claim 1, and described in the Applicant's specification.

Becker fails to expressly teach "insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party". However, this feature is well known in the art, as evidenced by Levison.

In particular, Levison discloses "insurance coverage is provided to at no cost to said customer due to the fact that said insurance coverage is paid for by said first party" (Levison; paragraphs: 0006 and 0034).

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It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Levison with the motivation of providing an incentive for a consumer to conduct business with a commercial enterprise (Levison; paragraph: 0006).

B. Claim 2, 4, 5, 6 have been amended to replace "item" with "particular article of personal property", and as explained above in the 35 U.S.C. 112, first paragraph rejection, the new term is not described in the Applicant's specification, and therefore Examiner considers that "the article of personal property" is "a particular item" or "an item" as recited in the original claim 1, and described in the Applicant's specification. Claims 2, 4, 5, 6 are rejected for the same reasons given in the previous office action (page number 5-6), and incorporated herein.

C. Claims 3, 7-9 have not been amended, Applicant does not appear to argue separate patentability for these claims. As such, claims 3, 7-9 are rejected for the same reasons given in the previous office action (page number 6-7), and incorporated herein.

D. Claim 17 has been amended now to recite "a unified property protection program comprising:

A service contract that is paid for by a first entity, said service contract providing protection against the mechanical breakdown or failure of a particular article of personal property (Becker; paragraphs: 0008, 0013);
and

Insurance coverage that is paid for by a second entity, said insurance coverage providing protection against one or more events selected from a group consisting of: (A) loss of said article of personal property, (B) theft of said article of personal property, and (C) other named perils associated with said article of personal property, wherein said personal property protection program is referenced by a single identification indicia.

The obviousness of modifying the teaching of Becker to include the Insurance coverage that is paid for by a second entity, said insurance coverage providing protection against loss of said article of personal property (as taught by Levison) is as addressed above in the rejection of claim 1 and incorporated herein.

Examiner considers that since there is a bundled registration and loss protection service and a database that can be registered the customer and updated by the customer and/or retailer, there is a single identification indicia in the Becker.

E. As per claim 19, Becker et al. discloses the property protection program of claim 17, wherein said service contract protects against the mechanical breakdown of one or more items (Becker et al.; 0015).

F. As per claim 20, Becker et al. discloses the property protection program of claim 17, wherein said insurance coverage protects against accidental damage to said one or more items (Becker et al.; 0015).

G. As per claim 21, Becker et al. discloses the property protection program of claim 19, wherein said insurance coverage protects against a loss other than accidental damage to said one or more items (Becker et al.; 0017 and 0018).

H. As per claim 22, Becker et al. discloses the personal protection program of claim 19, wherein said insurance coverage protects against the accidental damage to, or loss of, said one or more items (Becker et al.; 0017 and 0018).

I. Claims 23-25 have been amended now to replace "item" with "article of personal property" and as explained above in the 35 U.S.C. 112, first paragraph rejection, the new term is not described in the Applicant' specification, and therefore claims 23-25 are rejected for the same reasons given in the previous office action, and incorporated herein.

J. Claim 27 has been amended now to recite the property protection program of claim 17, wherein said property protection program provides that: (1) in response to said second entity failing to submit timely payment for said insurance coverage, said insurance coverage will be interrupted; and (2) said service contract will not be interrupted in response to said second entity failing to submit timely payment for said insurance coverage (Becker et al.; 0015 and 0018).

K. Claim 29 has been amended now to recite the property protection program of claim 27, wherein said product protection program provides that: (1) in response to said first entity failing to submit timely payment for said service contract, said first property coverage will be interrupted; and (2) said insurance coverage will be

interrupted in response to said first entity failing to submit timely payment for said service contract (Becker et al.; 0015 and 0018).

L. Claim 30 has not been amended, and Applicant does not appear to argue the separate patentability of this claim. As such, claim 30 is rejected for the same reasons given in the previous Office Action (paper number 30), and incorporated herein.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. (hereinafter Becker) (U.S. Patent Publication No. 2002/0165741 A1), Levison (U.S. Patent Publication No. 2002/0010599 A1) and further in view of Levison (U.S. Patent Publication No. 2002/0010599 A1).

A. Claim 26 has been amended now to replace "item" with "article of personal property" and as explained above in the 35 U.S.C. 112, first paragraph rejection, the new term is not described in the Applicant's specification, and therefore claim 26 is rejected for the same reasons given in the previous office action, and incorporated herein.

Response to Arguments

12. Applicant's arguments with respect to claims 1-9, 17, 19-25, 27, 29-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC

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04/11/2007


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